The opinion in support of the decision being entered today
is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* JEFFREY A. BEDELL, EDUARDO CARRANZA,
DOUGLAS L. EVERHART, WILLIAM HURWOOD, BENJAMIN Z. LI,
RAMKUMAR RAMACHANDRAN, DAVID B. SHERWOOD,
STEPHEN S. TRUNDLE, and ABHIMANYU WARIKOO

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Appeal 2007-1429
Application 09/883,501
Technology Center 2100

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Decided: July 26, 2007

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Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and
MAHSHID D. SAADAT, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final
rejection of claims 1-20, which are all of the claims pending in this
application. We have jurisdiction under 35 U.S.C. § 6(b).[1]

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[1] An oral hearing for this application was held on May 10, 2007.

Appellants' invention relates to reporting and decision support systems for retrieving data from data warehouses (Specification 1). According to Appellants, a report may be defined by untrained people through selection of prompt objects included in the report. Prompt objects contain a question to be answered, validation values for the answer, and attributes indicating how the prompt object is to be processed (Specification 2). A report instance or the actual execution of the report is passed to a server which collects all of the prompt objects or questions and places them in a resolution object (Specification 2:11 through 3:4). A resolution object may comprise a collection of answers (Specification 17). According to Appellants, instead of including portions of static report definition, a report may be defined more efficiently by selecting prompt objects that are resolved at run-time, allowing parameters of the report to be defined until the actual execution (Specification 14).

Independent Claim 9 is the broadest claim and reads as follows:

9.      A method for resolving reports that include prompt objects, wherein the prompt objects comprise a question to be asked of a user and at least one validation property, the method comprising the steps of:

receiving a report instance at a server system from a client that has initiated report execution of the report that includes one or more prompt objects;

gathering at the server system the one or more prompt objects referenced in the report;

generating a resolution object containing the one or more questions from the one or more prompt objects gathered;

interacting with a user to receive answers to one or more questions in the resolution object; and

executing the report upon receiving answers from a user to the one or more questions in the resolution object.

The prior art references relied upon by the Examiner in rejecting the claims on appeal are:

| McCann | US 5,963,939 | Oct. 5, 1999 |
| Poggi | US 6,569,205 B1 | May 27, 2003 |

The Examiner rejected claims 1-6, 8-12, and 14-20 under 35 U.S.C. § 103(a) as being unpatentable over McCann and claims 7 and 13 over McCann and Poggi.

We reverse.

### ISSUE

The Examiner contends that the user ID and the password entries in Figure 45 are the same as prompt objects which are used for generating a resolution object containing the questions from the prompt object as shown in Figure 58A of McCann (Answer 5). The Examiner further asserts that although McCann does not specifically teach executing, the "submit purchase order" button in Figure 57 suggests executing. (Answer 5-6).

Appellants contend that the ID and password of McCann are answers to a prompt and unrelated to a report and not included in the questions listed in Figure 58A (Br. 10). Appellants further argue that the purchase order depicted in Figure 58A cannot represent both the execution of the report and the results of a report (Reply Br. 6) and thus fails to indicate executing a report upon receiving answers from a user to one or more questions in the resolution object (Reply Br. 7).

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Therefore, the issue on appeal is whether the Examiner erred in finding claims 1-20 unpatentable for obviousness under 35 U.S.C. § 103(a) over McCann and Poggi. The issue specifically turns on whether a preponderance of the evidence before us shows that the user ID and password prompts of McCann are the same as the claimed prompt objects containing questions whose answers are used for executing the report upon receiving answers from a user.

## FINDINGS OF FACT

The following findings of fact (FF) are relevant to the issue under appeal:

1. McCann relates to an object-driven application based on publicly available information for identifying the needs of an end user and demonstrating the appropriateness of the solution selected by the user (Abstract).

2. McCann starts with a series of user interface screens such the one shown in Figure 45 for initial login and indicating the user's ID and password (col. 8, l. 64 through col. 9, l. 14).

3. McCann further shows a set of question blocks in Figures 58A-58V divided into categories of question blocks that are used to obtain answers from the user (col. 25, ll. 22-41).

4. After determining the items to be purchased by the user from the question blocks, an online purchase order form is accessed over the Internet that allows the user to contact the supplier and place an order (col. 68, ll. 28-51).

PRINCIPLES OF LAW

A claimed invention is unpatentable as obvious "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *See* 35 U.S.C. § 103(a) (2002); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999). "Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000), citing *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).

While "the common sense of those skilled in the art" may be relevant to an obviousness inquiry, *cf. Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*, Slip Op. 06-1402 (Fed. Cir. May 9, 2007), the ultimate consideration depends on "the differences between the subject matter sought to be patented and the prior art" and the level of "ordinary skill in the art." *See* 35 U.S.C. 103(a) (2002). Thus, a determination of obviousness requires us to:

1) determine the scope and content of the prior art;

2) ascertain differences between the prior art and the claims at issue; and

3) determine the level of ordinary skill in the art. *See Graham v. John Deere*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Further, a rejection based on section 103 must rest upon a factual basis rather than conjecture, or speculation. "Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand." *In re Warner*,

379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). *See also In re Lee,* 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) and *In re Kahn,* 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

## ANALYSIS

The Examiner does not show where the prior art teaches or suggests a one or more prompt objects included in a report instance sent by the client that has initiated report execution of the report. While McCann describes ID and password prompts, they do not form prompt objects in the report instance that relate to the execution of the report (FF 2). Thus, we agree with Appellants that questions of ID and password prompts are neither those gathered in question blocks of Figures 58A-58V, nor relate to these question blocks related to the prompts included in a report (Br. 10-11).

We also disagree with the Examiner's characterization of submitting the purchase order form of Figure 57 as the execution of the report since, as argued by Appellants (Reply Br. 6), the purchase order cannot be the execution of the report and the report itself (FF 3 & 4). In that regard, the step of submitting for purchase results in sending the generated list to a supplier and not executing the report upon receiving the user's answers to the questions included in the resolution object.

Even assuming, arguendo, that one of ordinary skill in the art would have found any reason to modify McCann, submitting the purchase order would not result in executing the report as the list in the purchase order is already the result of answering the questions from the question blocks.

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Claims 1 and 16 similarly include limitations related to prompt objects included in a report instance execution of the report upon receiving answers to questions from the prompt objects. Thus, we find that Examiner's rejection rests on speculation and less than a preponderance of the evidence and thus, fails to provide sufficient reasons for finding claims 1, 9, and 16, as well as claims 2-6, 8, 10-12, 14, 15, and 17-20 dependent thereon, unpatentable for obviousness under 35 U.S.C. § 103(a) over McCann.

With respect to the rejection of claims 7 and 13 over the combination of McCann and Poggi, we note that the Examiner has not pointed to any teachings in Poggi that would have overcome the deficiency of McCann as discussed above. Thus, we cannot sustain the 35 U.S.C. § 103 rejection of claims 7 and 13 as being unpatentable over McCann and Poggi.

## DECISION

The decision of the Examiner rejecting claims 4-9 under 35 U.S.C. § 103 is reversed.

REVERSED

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